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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,789

03/15/2007

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EXAMINER

WEINER, LAURA S

ART UNIT

PAPER NUMBER

1726

MAIL DATE

DELIVERY MODE

05/12/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,789	Applicant(s) YOSHIKATA ET AL.	
	Examiner /Laura S. Weiner/	Art Unit 1726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7-11,13-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,7-11,17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 13-15, 19-20 in the reply filed on 1-6-2011 is acknowledged.

2. Claims 2, 7-11, 17-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1-6-2011.

Response to Arguments

3. Applicant's arguments with respect to claims 13-15, 19-20 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 1726

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 13-14, 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,517,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 7,517,601 claims in claim 1, a solid oxide fuel cell comprising at least one single cell having an electrolyte, a fuel cell electrode and an air electrode wherein the fuel cell is provided with a substrate that supports the single cell,

Art Unit: 1726

the electrolyte is disposed on one surface of the substrate, and the fuel cell electrode and the air electrode disposed on the first surface of the substrate sandwiching the electrolyte in between them. U.S. Patent No. 7,517,601 claims in claim 5, wherein a plurality of single cells are disposed on the substrate, and these first single cells are connected by an interconnector. U.S. Patent No. 7,517,601 claims in claim 7, a solid oxide fuel cell comprising at least one first single cell having an electrolyte, a fuel electrode and an air electrode wherein the fuel cell is provided with a substrate that supports the first single cell; the electrolyte is disposed on a first surface of the substrate and one of the fuel electrode and the air electrode is disposed on the electrolyte and the other of the fuel electrode and the air electrode is not in contact with the electrode disposed on the electrolyte. U.S. Patent No. 7,517,601 claims in claim 9, that a plurality of the first single cells are disposed on the substrate and are connected to each other by an interconnector. U.S. Patent No. 7,517,601 claims in claim 10, that the electrolyte, the fuel electrode and the air electrode are formed by a printing method.

Claim Rejections - 35 USC § 102

6. Claims 13, 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii et al., WO 02/080299 and/or under 35 U.S.C. 102(e) as being anticipated by Fujii et al., US 7,081,317.

Fujii et al. ('317) teaches a thin film fuel cell having a substrate 11, an electrolyte 13, a fuel electrode 12, an air electrode 14 and an interconnect 15 (Figure 1). Note mask layer 17 is removed to produce the finished fuel cell. The thickness of the

Art Unit: 1726

electrolyte 13 is 0.5 to 5 μm (5:54-55). As shown in at least Figure 1 the electrolyte 13, fuel electrode 12 and air electrode 14 each contact a first surface of the substrate 11 with the electrolyte located between the fuel electrode 12 and the air electrode 14. Figure 4 shows a second thin film fuel cell formed on a second surface of a substrate. Figure 1 also shows the thickness of the electrolyte between the air electrode and the fuel electrode is thickness than the fuel electrode. Fuji teaches a first side edge of the electrolyte contacts the cathode and a second side edge of the electrolyte contacts the anode (see Figure 1).

7. Claims 14 and 19 are rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, or alternatively unpatentable over, Fujii et al., WO 02/080299 and/or under 35 U.S.C. 102(e)/103(a) as being anticipated by, or alternatively unpatentable over, Fujii et al., US 7,081,317.

Fujii et al. ('317) teaches a thin film fuel cell having a substrate 11, an electrolyte 13, a fuel electrode 12, an air electrode 14 and an interconnect 15 (Figure 1). Note mask layer 17 is removed to produce the finished fuel cell. The thickness of the electrolyte 13 is 0.5 to 5 μm (5:54-55). As shown in at least Figure 1 the electrolyte 13, fuel electrode 12 and air electrode 14 each contact a first surface of the substrate 11 with the electrolyte located between the fuel electrode 12 and the air electrode 14. Figure 4 shows a second thin film fuel cell formed on a second surface of a substrate. Figure 1 also shows the thickness of the electrolyte between the air electrode and the fuel electrode is thickness than the fuel electrode. Fuji teaches a first side edge of the

Art Unit: 1726

electrolyte contacts the cathode and a second side edge of the electrolyte contacts the anode (see Figure 1).

Thus the claim is anticipated. The claim is alternatively unpatentable because the courts have ruled that product-by-process limitations, in the absence of unexpected results, are obvious. See MPEP 2113.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1726

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Laura S. Weiner/ whose telephone number is 571-272-1294. The examiner can normally be reached on M-H (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura S Weiner/
Primary Examiner
Art Unit 1726

May 9, 2011